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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,523	03/19/2001	Masao Minobe	Q65488	6184

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WASHINGTON, DC 20037

EXAMINER
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NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 02/11/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicant(s)

09/810,523

MINOBE ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 18-31,34,35,38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17,32,33,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the amendment (Paper No. 13) submitted by applicant on 11/04/2002.

### ***Oath/Declaration***

2. The objection to the oath or declaration made in previous Office action is overcome by the filing of the new Oath/declaration which complies with the requirements.

### ***Drawings***

3. The objections to the drawings as set forth in the previous Office action (Paper No. 11, page 3) are repeated. In particular, the feature concerning the mechanism for adjusting the distance between the diffraction image plane and the sample as recited in each of claims 4 and 15, and the feature concerning the mechanism for adjusting/aligning the direction of light through the spatial filter and the optical axis of the objective lens as recited in each of claims 5 and 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 36 and 37 are rejected under 35 U.S.C. 112, first paragraph for the same reason as set forth in the previous Office action (Paper No. 11, pages 4-5).

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-17, 32-33, 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph because it is unclear about the structure for converging light transmitted or reflected from the same as recited in the feature thereof "illuminating means... a space" (lines 2-3). In particular, it is unclear how many times the light from the illuminating means being converged. Is applicant's intend to say that the light is converged by the illuminating means and then convergent again at a point in space?

d) Each of claims 32, 33, 36 and 37 is rejected under 35 USC 112, second paragraph for the similar reason as set forth in element a) above.

f) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1 and 6, as best as understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Greenberg (U.S. Patent No. 5,305,139, of record).

See the rejection as set forth in the previous Office action (Paper No. 11, page 7).

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg in view of Shimada et al (of record).

See the rejection as set forth in previous Office action (Paper No. 11, pages 7-8).

12. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg in view of Ellis (of record).

See the rejection as set forth in previous Office action (Paper No. 11, pages 8-9).

13. Claim 13, as best as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg in view of Ellis as applied to claim 7 above, and further in view of Shimada et al.

See the rejection as set forth in previous Office action (Paper No. 11, page 9).

***Allowable Subject Matter***

14. Claims 3-5 and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if each of claims 3 and 14 is rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claims 32 and 33 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

16. Applicant's arguments filed on 11/4/2002 have been fully considered but they are not persuasive.

A) The mentioned objections to the drawings are repeated from the previous Office action. Applicant's arguments provided in the amendment (Paper No. 13, pages 8-10) have been fully considered but they are not persuasive. Applicant has argued that the specification discloses that since the specification disclosed that the condenser lens is moved; therefore, the feature relating to the mechanism for adjusting the distance is adequately shown in the drawings. The Examiner respectfully disagrees. The examiner did not make an objection to the specification. The Examiner made an objection to the drawing because the drawings fail to disclose the feature claimed. With regard to the applicant's arguments that the drawings adequately show the feature claimed, the Examiner respectfully disagrees. Applicant must amend the drawing to show that the condenser lens is moved along the optical axis via a mechanism. The mechanism could be shown in the form of a box if the mechanism is known in the art. See 37 CFR 1.83(a).

B) In regard to the rejection of the claims under 35 USC 112, first paragraph, applicant's arguments as provided in the amendment (Paper No. 13, pages 12-13) have been fully considered but they are not persuasive. Applicant has argued that since the term "comprises" is used in the claim; therefore, the claim can contain additional steps. The examiner respectfully disagrees and respectfully invited the applicant to review MPEP, sections 2164.08(a) which clearly discloses that a single means claim is

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subjected to a rejection under 35 USC 112, first paragraph because the single means claim draws to only a single element instead of a combination. A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor. Applicant should note confused with the open range offered by the use of the term "comprising". While the term "comprises" in the claim introduces the claim can contain more than one single element or step; however, all of the additional elements or steps not disclosed in the claim are not supported in the specification the specification disclosed at most only those means known to the inventor.

With regard to applicant's arguments that the specification at page 41 discloses the manner in which the size of diffraction image is adjustable to support for the rejection of the single means claim, the Examiner respectfully disagrees with the applicant's opinion. Applicant should note that the claim(s) is/are examined in the light of the requirements such as 35 USC 112, 35 USC 102, etc..

C) In regard to the rejection of the claim under 35 USC 102, applicant's arguments as provided in the amendment (Paper No. 13, pages 15-16) have been fully considered but they are not persuasive. Applicant should note that all of the features recited in the claim are clearly disclosed by Greenberg. In particular, Greenberg discloses a microscope having an illuminating system. The device as described in columns 3-5 and 7-12 and shown in figs. 2 for example, comprises an illuminating system for providing light which is converged onto a point in space (see the point

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between the plane defined by the specimen 20 and the objective lens 14), a stage (17) for supporting a sample (20) located in front of the converged point with respect to the direction of the incoming light from the light source, and an objective system (14) located after the point for receiving light passing through the converged point.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

D) With regard to the rejections of the claims under 35 USC 103(a), since applicant has not provided any specific arguments except the reference to the argument applied to claim 1; therefore, the claims still rejected for the same reasons as set forth in the previous Office action.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



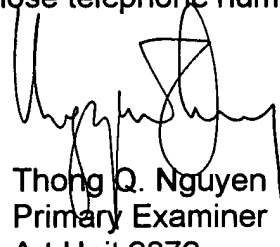
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen  
Primary Examiner  
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February 6, 2003